

**REMARKS**

The Office Action dated October 23, 2003 has been reviewed and carefully considered. Claims 1-4 are pending in this application, of which the independent claims are 1 and 4. Claim 4 has been amended to delete a typographical error, but claims 1-4 have not otherwise been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 1-4 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,414,991 to Yagasaki et al. ("Yagasaki") in view of U.S. Patent No. 6,057,884 to Chen et al. ("Chen").

Claim 1 recites "(B) coding a plurality of successive video object planes (VOPs) of each of said VOs, said coding step itself comprising sub-steps of (i) coding the texture of said VOPs, . . . , wherein sub-step (B)(i) comprises: . . . wherein the temporal reference of the enhancement layer P-VOPs is selected only as the temporally closest candidate, and the temporal references of the enhancement layer B-VOPs are selected as the two temporally closest candidates, in either case without any consideration of the layer to which the temporally closest candidates belong."

Yagasaki, by contrast, firstly fails to disclose that "the temporal references of the enhancement layer B-VOPs are selected as the two temporally closest candidates." For example, VOP1 is one of the temporal references selected for the enhancement layer B-VOP, "VOP3", in FIG. 14. Although the temporal distance between VOP2 and VOP3 is less than the temporal distance between VOP1 and VOP3, VOP1 is nevertheless selected as the temporal reference. Accordingly, Yagasaki discloses that VOP1 is

selected as the temporal reference, even though VOP1 is not one of “the two temporally closest candidates” as explicitly required by the language of claim 1.

Item 1 of the Response to Arguments section of the Office Action suggests that the words “immediately before” and “immediately after” mentioned, in connection with the enhancement layer B-VOPs, in various locations in column 15 of Yagasaki between lines 42 and 64 imply that the temporally closest candidates are selected as the temporal references. The applicant traverses this proposition. In each instance, the expression “immediately before” and “immediately after” refers to the layer from which the temporal reference is selected, i.e., the base layer or the enhancement layer, but does not imply or suggest that the selected candidates are “the two temporally closest candidates” as explicitly required by the language of claim 1. In fact, the above-described counterexample depicted in FIG. 14 demonstrates that there is no implication or suggestion that the selected candidates are the temporally closest candidates.

In apparent recognition of the futility of the proposition being offered, item 1 of the Response to Arguments section of the Office Action suggest that, even if there is no disclosure of the closest candidates being selected as “temporal references of the enhancement layer B-VOPs,” “the capability of using the closest temporal candidate is present in Yagasaki.” However, as mentioned in the instant specification, the MPEG-4 standard leaves open to the user the decision as to which of the specified three candidates to chose as the selected temporal references (specification, page 2, lines 16-22). The user, therefore by definition, always has the option of choosing among candidates based on any criterion, whether that is temporal proximity or some other criterion. There is no

suggestion, however, in Yagasaki to select the temporally closest two candidates. This shortcoming in Yagasaki has been demonstrated above by the counterexample.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) MPEP 2143.

Since there is no suggestion in Yagasaki of selecting the two temporally closest candidates, the basis for the claim rejection is unclear.

As item 2 of the Response to Arguments section of the Office Action acknowledges, the secondary reference, Chen, likewise fails to disclose or suggest the feature of selecting the two temporally closest candidates. Accordingly, for at least reasons set forth above, it is unclear to the applicant what proper basis exists for asserting that it would have been obvious to select the two temporally closest candidates.

Reconsideration and withdrawal of the rejection is respectfully requested.

As to apparatus claim 4, it is based on method claim 1, and likewise is deemed to be non-obvious over the prior art of record for at least the same reasons.

The other rejected claims depend from claim 1 and are deemed to distinguish patentably over the cited prior art for at least the same reasons.

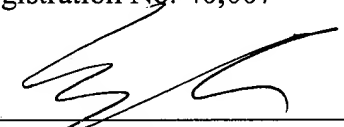
New claim 5 has been added to emphasize certain aspects of the invention. Support for new claim 5 is found in the specification (e.g., page 2, lines 1-3).

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Russell Gross  
Registration No. 40,007

Date: 12/4/03

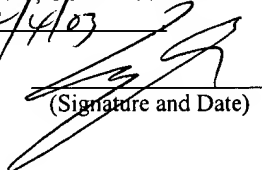
  
By: Steve Cha  
Attorney for Applicant  
Registration No. 44,069

**Mail all correspondence to:**  
Russell Gross, Registration No. 40,007  
US PHILIPS CORPORATION  
P.O. Box 3001  
Briarcliff Manor, NY 10510-8001  
Phone: (914) 333-9624  
Fax: (914) 332-0615

**Certificate of Mailing Under 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA. 22313 on 12/4/03

Steve Cha, Reg. No. 44,069  
(Name of Registered Rep.)

  
(Signature and Date)